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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William J. Baer

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/488,969	<b>Applicant(s)</b> BAER ET AL.	
	<b>Examiner</b> Maikhanh Nguyen	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/08 &amp; 4/23/08</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the RCE filed 04/07/2008.

Claims 1-15 are currently pending in this application. Claims 1, 6, and 11 have been amended. Claims 1, 6, and 11 are independent claims.

### **Request Continuation for Examination**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 04/07/2008 has been entered.

### **Information Disclosure Statement**

3. The Applicants' Information Disclosure Statements, filed 04/07/2008 and 04/23/2008, have been received, entered into the record, and considered.

### **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 recites a system, the claims recites a computer network system comprising “means for adding or removing,” “means for examining,” and “means for automatically adding or removing.” As currently recited the “system” comprises only computer software elements. Thus, the claim is a program per se and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

For the same reasons discussed supra with respect to independent method claim 11, the system claims 12-15 fall outside the scope of § 101.

### **Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or "* (Emphasis added.)

Claims 1-3, 6-8, and 11-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by **Mortimer et al.** (US Patent No. 6091930, filed 03/04/1997).

#### **As to claims 1, 6, and 11:**

Mortimer teaches a method, program storage device, and system for providing prerequisite checking in a system for creating a content object (*generates a professor CITbook 40*), being one of a book, a document, a collection of images, a collection of musical selections, a video and a multimedia object, from a plurality of individual content entities including content for the content object and stored in a data repository as a plurality of individual file objects, some of the content entities being prerequisites to

others of the content entities and the content object being defined by a list indicating the content entities from the data repository specified by a user for the content object *[see the Abstract and col. 6, lines 15-22]*, the method comprising the steps of:

- adding or removing a selected content entity to or from the list to indicating the content entities from the data repository specified by the user for the content object to add or remove the selected content entity to or from the content object *[See Col. 18, line 61- Col.19, line 28 and Col. 22, lines 37-52: the professor CITbook 40, for a specified group of chapters, links are created in a predetermined or preferred sequence linking the material together to define a primary route through the chapters similar to a course syllabus ... the form of pointers, addresses, indexes, linked lists, trees, or any other data ... connect a series of topics or chapters of a selected subject in a predetermined primary sequence in order to simulate a sequence of an actual text book ... focus on only selected topic which are deemed important for a particular class)*, wherein a prerequisite content entity is associated with another content entity and designated for inclusion in each content objects for which that other content entity is selected and placed *[See Col. 6, lines 54-67; Col. 7, line 39 - Col. 8, line 67;and Col. 15, line 37- Col. 16, line 12: a set of predefined data-entry rules 74 or specifications for the document-entry ... specifying a selected data format which the data must comply with before it is accepted ... provide for formatting, organizing, categorizing and integrating the inputted material into a professor CITbook ...*

*generating a set of rules and restrictions with which inputted information must comply ... the rules are easily complied with allowing the user to focus on entering the content of the material. With the selected entry rules, all information inputted into the interactive system will have a standard and uniform format), and wherein designations prerequisite content entities for content entities within the data repository are stored external of the individual file objects containing the content entities [See Col. 16, lines 25-47: assembles files containing audio/video clips, images, illustrations, simulations, embedded or background text, and the main text which is the controlling component of the material, the expert contribution manager 210 links, stores, and formats the new material and incorporates it into the student CITbook 50 ... images, videos, and simulations will still be edited and stored elsewhere, but the expert contribution manage];*

- examining the stored associations between content entities and prerequisite content entities and determining if the selected content entity has any prerequisite content entities designated for that content entity [See Col. 7, lines 38-62; Col. 8, lines 39-51; and Col.13, lines 18-32: data including text, images, illustrations, simulations, audio and video for inclusions ... determine which portions of the collected data are well-accepted among experts in the relevant field. The well-accepted data includes data which is believed to be "true" at the time of review and of course includes established proven theories and topics. The set of well-accepted data is considered the "truth" in the relevant field of study and forms a

*primary knowledge base of the professor CITbook 40. Preferably, a separate professor CITbook 40 is generated for each selected scientific area or subject matter],*

and if so, automatically adding or removing the designated prerequisite content entities to or from the list in direct response to user interaction initiating the addition or removal of the selected content entity to add or remove the prerequisite content entities to or from the content object [See Col. 14, lines 37-50; see also, Claim 16: dynamically changing the presentation sequence in which the selected subjects are presented to the student based upon the student activating a selected one of the plurality of secondary link sequences].

**As to claims 2, 7, and 12:**

Mortimer teaches one or more of the prerequisites are conditional [See Col. 15, line 52-col. 16, line 12: a set of rules and restrictions with which inputted information must comply].

**As to claims 3, 8, and 13:**

Mortimer teaches the conditions for applying a prerequisite are defined in one or more rules [See Col.8, lines 18-51: a set of predefined data-entry rules 74 or specifications for the document-entry process. The rules include specifying a selected data format which the data must comply with before it is accepted by the interactive system. The data-entry



*rules provide for formatting, organizing, categorizing and integrating the inputted material into a professor CITbook ... rules 74 also include categorization rules which determine the category of each portion of entered text such as "Subject Matter," "Topic," "Chapter Title," and "Education Level." Categorization is performed for example by searching for key words or requesting the data-entry person to identify the material].*

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 4-5, 9-10, and 14-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Mortimer et al.** in view of **Tabuchi** (U.S. 6,606,633, filed 09/1999).

#### **As to claims 4, 9 and 14:**

Tabuchi teaches in the case of more than one of the rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller

set of rules [See *Col. 4, lines 4-60; Col. 10, line 59 - Col. 11, line 36 & see fig.5 and the associated text*].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mortimer with Tabuchi because it would have provided the capability for checking a possibility/impossibility of relating of a data object with reference to the structuring rule table, and the compound document object, when newly relating to other object, inquires of the rule searching means whether relating of the objects in a desired relation is possible or not.

**As to claims 5, 10 and 15:**

Tabuchi teaches the step of rewriting any negative rules as positive rules [See *Col.11, lines 23-37: whether a structuring rule is being used in a compound document object or can not be recognized ... when the number of references of the designated structuring rule is not 0, the structuring rule in question will not be deleted*].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Mortimer with Tabuchi because it would have provided the capability for checking a possibility/impossibility of relating of a data object with reference to the structuring rule table, and the compound document object, when newly relating to other object, inquires of the rule searching means whether relating of the objects in a desired relation is possible or not.

### **Response to Arguments**

7. Applicant's arguments filed 04/07/2008 have been fully considered but they are not persuasive.

The Examiner would like to thank Applicant for the amendment responsive to the previous Office Action. However, after further review of the amended claims and the Mortimer reference, the Examiner believes that the Mortimer reference must be cited as it reads-on the claim limitations.

### **Conclusion**

8. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

### **Contact information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. N./

Examiner, Art Unit 2176

/Stephen S. Hong/  
Supervisory Patent Examiner, Art Unit 2178

